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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,599	12/02/2005	Athol Gillies Turner	048501/303751	1531

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EXAMINER

CLARK, AMY LYNN

ART UNIT	PAPER NUMBER
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1655

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,599

Applicant(s)

TURNER, ATHOL GILLIES

Examiner

Amy L. Clark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9, drawn to a solid state process for the production of fats or oils and/or their extracts containing biologically active chemical compounds from a lipid substrate.

Group II, claim(s) 10, drawn to a biologically active fat or oil and extracts thereof produced according to the process of claim 1.

Group III, claim(s) 11-23, drawn to a method of treating or preventing a disease or condition in a human or animal patient, which comprises administration to the patient an effective amount of a biologically active fat or oil or extract thereof, produced according to the process of claim 1.

Group IV, claim(s) 24 and 25, drawn to a use of a biologically active fat or oil and extracts thereof as claimed in claim 10 in the manufacture of a medicament for the treatment of an inflammatory disease or condition in a human or mammal.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claim 10, at least, is anticipated by or obvious over Hibbard (N, GB 2,293,547 A). Hibbard teaches substances and compositions containing oil from plants of the genus *Melaleuca* (tea tree) have activity against oral infections and tea tree oil has been used to treat a variety of human ailments, is useful in surgery, medicine and dentistry (See Abstract and page 1, lines 1-34). It should be noted that Claim 10 constitutes a Product-by-Process type claims. In Product-by-Process type claims, the process of producing the product is given no patentable weight since it does not impart novelty to a product when the product is taught by the prior art. See *In re Thorpe*, 227 USPQ 964

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(CAFC 1985); *In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983) and *In re Brown*, 173 USPQ 685 (CCPA 1972). Consequently, even if a particular process used to prepare a product is novel and unobvious over the prior art, the product *per se*, even when limited to the particular process, is unpatentable over the same product taught in by the prior art. See *In re King*, 107 F.2d 618, 620, 43 USPQ 400, 402 (CCPA 1939); *In re Merz*, 97 F.2d 599, 601, 38 USPQ 143-145 (CCPA 1938); *In re Bergy*, 563 F.2d 1031, 1035, 195 USPQ 344, 348 (CCPA 1977) *vacated* 438 US 902 (1978); and *United States v. Ciba-Geigy Corp.*, 508 F. Supp. 1157, 1171, 211 USPQ 529, 543 (DNJ 1979). Finally, since the Patent Office does not have the facilities for examining and comparing Applicant's composition with the compositions of the prior art reference, the burden is upon Applicant to show a distinction between the material, structural and functional characteristics of the claimed composition and the composition of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). Consequently, the special technical feature which links the claims does not provide a contribution over the prior art, so unity of the invention is lacking.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Group I: Elect either Specie A or Specie B.

Specie A: Claims 1, 3, 5, 7 and 9.

-Please note that if Specie A is elected, claims 2, 4, 6 and 8 will not be examined.

Specie B: Claims 2, 4, 6 and 8.

-Please note that if Specie B is elected, claims 1, 3, 5, 7 and 9 will not be examined.

Group III: Please elect from within i.) and also within ii.), not between i.) and ii.).

i.) Elect only one disease or condition from either claim 13, 14, 15, 16, 17, 18 or 19.

ii.) Elect one source of pathogenesis from claim 20, 21 or 22 that is consistent with the disease or condition elected from i.).

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Group I:

Specie A: claims 1, 3, 5, 7 and 9.

Specie B: claims 2, 4, 6 and 8.

Group III:

i.) If the disease or condition is elected from claim 13, then claims 11-13, possibly one of claims 20-22 and 23; if the disease or condition is elected from claim 14, then claims 11, 12, 14, possibly one of claims 20-22 and 23; if the disease or condition is elected from claim 15, then claims 11, 12, 15, possibly one of claims 20-22 and 23; if the disease or condition is elected from claim 16, then claims 11, 12, 16, possibly one of claims 20-22 and 23; if the disease or condition is elected from claim 17, then claims 11, 12, 17, possibly one of claims 20-22 and 23; if the disease or condition is elected from claim 18, then claims 11, 12, 18, possibly one of claims 20-22 and 23; and if the disease or condition is

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elected from claim 19, then claims 11, 12, 19, possibly one of claims 20-22 and 23.

ii.) If the source of pathogenesis is elected from claim 20, then claim 11, 12, possibly one of claims 13-19 and 23; if the source of pathogenesis is elected from claim 21, then claim 11, 12, possibly one of claims 13-19 and 23; and if the source of pathogenesis is elected from claim 22, then claim 11, 12, possibly one of claims 13-19 and 23.

The following claim(s) are generic: claims 1, 2, 10, 11 and 24.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

There is no common core shared by all of the alternatives.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy L. Clark
AU 1655

Amy L. Clark
June 22, 2007


MICHELE FLOOD
PRIMARY EXAMINER